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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,382	11/17/2003	Gordon Lynn Blumenschein	8285-663	4357

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EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,382	Applicant(s) BLUMENSCHN ET AL.	
	Examiner Allan Hoosain	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-22 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. 6,424,702 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

US 6,424,702, recites limitations which are substantially the same and broader in scope as recited in the claims of the instant Application. For example, US 6,424,702, Claim 4, incorporates the limitations of Claim 1 in the instant application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,3-4,8-9,19-20 rejected under 35 U.S.C. 102(e) as being anticipated by **Alperovich et al.** (US 6,101,393).

As to Claims 1,19-20, with respect to Figures 3-5, **Alperovich** teaches a method comprising preventing a message delivery service from being offered to a caller of an employee (a called

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party) if the employee (called party) is included in a list that identifies employees (called parties) who are restricted from receiving messages from non-employee callers (do not want the message delivery service to deliver caller messages to them) (Figure 5 and Col. 6, lines 7-15).

As to Claims 3, **Alperovich** teaches the invention of Claim 1 further comprising:

receiving a request from the called party to be included in the list (Figure 6); and
adding the called party to the list (Figure 6 and Col. 5, lines 51-66).

As to Claims 4, **Alperovich** teaches the invention of Claim 3, wherein a service management system adds the called party to the list (Col. 5, lines 51-66).

As to Claims 8, **Alperovich** teaches the invention of Claim 1, wherein the list comprises numbers (Figure 5, labels 522,532).

As to Claims 9, **Alperovich** teaches the invention of Claim 1, wherein a service control point performs the preventing act (Figure 2, label 26 and Figure 4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10,12-13,17-18,21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alperovich** in view of **Helferich** (US 6,259,892).

As to Claim 10,12-13,17,18, **Alperovich** teaches a method comprising preventing a message from being delivered to a called party if the called party is included in a list that identifies called parties who do not want a message delivered to them'

Alperovich does not teach the following limitation:

“wherein the message comprises a voice message recorded during a call from a caller to the called party”

Helferich teaches a system which records voice messages and short messages for called parties (Col. 3, lines 15-26) and suggests the integration of voice message and short message systems . Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add voice message capability to **Alperovich's**

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invention for inclusion in the short message system as taught by **Helferich's** invention in order to provide selective acceptance or rejection of voice messages as is done for short messages.

8. Claims 2,5-7,11,14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alperovich** in view of **Helferich** (US 6,259,892) and further in view of **Bartholomew et al.** (US 6,215,858).

As to Claims 2,11, **Alperovich** teaches the invention of Claim 1 further comprising:

Alperovich does not teach the following limitation:

“offering the message delivery service to the caller if the called party is not included in the list”

However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches reject callers and returning appropriate messages to callers (Col. 5, lines 47-50).

Helferich teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7, lines 8-30). **Bartholomew** teaches offering callers who are not subscribers (on a called party list) voice mail message delivery (Col. 24, lines 57-63 and Col. 25, lines 5-10). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add voice mail service to **Alperovich's** invention to callers as taught by **Helferich's** invention and voice message delivery service to **Alperovich's** invention to called parties who are not subscribers as taught by **Bartholomew's** invention in order to provide voice messages for called parties who are busy.

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As to Claims 5,14, **Alperovich** teaches the invention of Claim 1 further comprising determining if the called party is included in the list:

Alperovich does not teach the following limitation:

“if the called party has not answered the call after a predetermined time”

However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches later delivery for unavailable subscribers (Col. 4, lines 57-62). **Helferich** teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7, lines 8-30). **Bartholomew** teaches no answer conditions for called parties (predetermined time) (Col. 24, lines 57-63 and Col. 25, lines 5-10). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add voice mail service to **Alperovich**'s invention to callers as taught by **Helferich**'s invention and no answer conditions to **Alperovich**'s invention for monitoring called parties as taught by **Bartholomew**'s invention in order to provide voice message services to callers.

As to Claims 6-7,15-16, **Alperovich** teaches the invention of Claim 1,

Alperovich does not teach the following limitation:

“wherein the list comprises caller-ID information”

However, it is obvious that **Alperovich** suggests the limitation. This is because **Alperovich** teaches lists with MSISDN numbers (Figure 5, label 522). **Helferich** teaches prompting callers to leave messages for called parties (Figure 4B and Col. 7, lines 8-30). **Bartholomew** teaches caller ID and names (Col. 17, lines 10-34). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the

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art to add voice mail service to **Alperovich's** invention to callers as taught by **Helferich's** invention and caller ID information to **Alperovich's** invention to identify callers to subscribers as taught by **Bartholomew's** invention in order to provide voice message services to callers and subscribers.

Response to Arguments

9. Applicant's arguments filed in the 2/17/05 Remarks have been fully considered but they are not persuasive because of the following:

The amendments and arguments to the 35 USC 112 rejections were satisfactory and, therefore, the rejections were withdrawn.

With respect to Claims 1 and 19, **Alperovich** teaches that confirmations are sent to callers indicating the reasons why the messages were not delivered (see Abstract). This teaching shows that message delivery to the callers was prevented.

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Valentine et al. (US 6,088,589) teach determining whether to send text messages to mobile users.

Owens et al. (US 6,633,630) teach integration of voice and text messages for delivery to users.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 306-0377 (for customer service assistance)

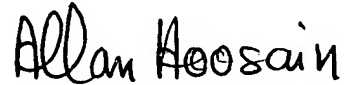
Hand-delivered responses should be brought to Carlyle, Alexandria,
VA 22313 (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.


Allan Hoosain
Primary Examiner
6/22/05